

Remarks:

Claims 35-46 are pending. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 35-40 and 43-46 are amended. Claims 41 and 42 are canceled. No new matter is added as support for the amendments is found within the Specification and the drawings. It is submitted that the application, as amended, is in condition for allowance.

Applicant is not conceding that the subject matter encompassed by claims 41 and 42 prior to this Amendment is not patentable over the art cited by the Examiner. Claims 41 and 42 were canceled in this Amendment solely to facilitate expeditious prosecution of the allowable subject matter noted by the Examiner. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claims 41 and 42 as presented prior to this Amendment and additional claims in one or more continuing applications.

§112 Rejection(s):

Claims 35-39 and 42 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. It is respectfully noted that this rejection is moot with respect to claim 42 as claim 42 has been canceled. Claim 35 has been amended to clearly point out that the amplifier external to the audio processor in the second state is the same amplifier external to the audio processor in the third state.

§103 Rejection(s):

Claims 35-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant-admitted prior art (hereafter “AAPA”) in view of U.S. Patent No. 6,259,935 to Saiki et al. (hereafter “Saiki”). This rejection is respectfully traversed.

MPEP §2143 provides:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

AAPA discloses an audio amplifier 12 external to the audio processor that amplifies voice (i.e., analog) signals. See figure 2, paragraphs [0010] and [0012]. Nowhere in AAPA is it disclosed that the audio amplifier 12 amplifies ring tone or signals that produce a vibration.

As such, AAPA fails to disclose “in the first state, amplifying audio signals in a processor of the mobile communication system,” “in the second state, amplifying ring tone signals in an amplifier external to the audio processor,” and “in the third state, amplifying a signal in the amplifier external to the audio processor,” as recited in claim 35. In fact, AAPA directly teaches away from the claimed subject matter by teaching that voice signals are amplified externally from the audio processor instead of from within the audio processor, as recited in claim 35. Accordingly, AAPA should be withdrawn for being an improper reference.

Further, as admitted by the Examiner on page 4 of the Office Action, AAPA also fails to disclose “[in the first state] removing low frequency resonance components in the amplified audio signals that fall below a first threshold, and providing the amplified, filtered audio signals to the MFD” and “[in the second state] removing low frequency resonance components in the amplified ring tone signals that fall below a first threshold, and providing the amplified, filtered ring tone signals to the MFD,” as recited in claim 35.

Saiki is directed to an electro-mechanical-acoustic transducer for converting an input electric signal into vibration, sound, or vibration and sound. The transducer applies a low-pass filter to signals to generate vibration, a high-pass filter to generate sound, and both the low-pass filter and the high-pass filter to generate vibration and sound. See Abstract; column 12, lines 5-16 and 42-46.

Applying any filter, even a low-pass filter, to signals to generate vibration, as disclosed in Saiki, directly teaches away from providing a non-filtered signal to produce vibration, as recited

in claim 35. Therefore, a person of ordinary skill in the art could not be motivated to combine Saiki with AAPA as the resulting combination would be inconsistent.

Assuming, arguendo, that Saiki can be combined with AAPA, Saiki fails to cure the deficiencies of AAPA as Saiki also fails to teach or suggest “in the first state, amplifying audio signals in an audio processor of the mobile communication system; in the second state, amplifying ring tone signals in an amplifier external to the audio processor; and in the third state, amplifying a signal in the amplifier external to the audio processor and providing the amplified, non-filtered signal to the MFD to produce a vibration,” as recited in claim 35.

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant’s disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner’s statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejection be withdrawn.

For the above reasons, neither AAPA nor Saiki, either alone or in combination, teach or suggest all the elements recited in claim 35. Therefore, it is respectfully submitted that claim 35 is in condition for allowance. Claims 36-39 depend on claim 35 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Amended claim 40 substantially incorporates the elements of claim 35; therefore, claim 40 and claims 43-46 depending from claim 40 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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